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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jeffrey Coutts

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EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/027,163

Applicant(s)

COUTS ET AL.

Examiner

Djenane M. Bayard

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2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This is in response to Request for continuation in which claims 1-20 are pending.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “ wherein the communication message includes an originating identification associated with the originating device and a target identification associated with the target device” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the **Remarks/ Arguments** dated 3/01/06, Applicant provided support for the additional recitation at pages 5-7, 12 and 20. However, those pages failed to provide for “wherein the communication message includes an originating identification associated with the originating device and a target identification associated with the target device”.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 14, 16-20 recite the limitation " the message proxy". There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 6, 8, 11-13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6584494 to Manabe et al in view of U.S. Patent No. 6, 993564 to Whitten, II.

a. As per claim 1, Manabe et al teaches a communication support system and method for promoting smooth communication in a chat system. Furthermore, Manabe et al teaches a method for a data network system for responding to a communication message, the method comprising the steps of: receiving a communication message directed to a target device from an originating device (See col. 4, lines 31-32 and col. 6, lines 35-41, the detection means detects the sending of any text information from a first communication device on the network); retrieving configuration data of the target device; determining whether the target device is available for interactive communication with the originating device based on the configuration data (See col. 4, lines 32-39 and col. 6, lines 46-50, the acquisition means detects whether a second

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communication device correlated with the detected text information is operating and acquires from the second communication device the user status); routing the communication message to the target device if the target device is available for interactive communication with the originating device (See col. 8, lines 62-65 and figure 7); and sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 7, lines 42-65). Furthermore, Manabe et al teaches wherein the communication message includes an originating identification associated with the originating device and a target identification associated with the target device (See col. 3, lines 10-15 and col. 4, lines 30-40). However, Manabe et al fails to teach retrieving configuration data of the target device based on the target identification, the configuration data including a plurality of classes and a plurality of canned replies associated with the plurality of classes and identifying an originating class of the originating device from the plurality of classes and a canned reply associated with originating class based on the originating identification.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203. Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send

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an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

b. As per claim 2, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the interactive communication is conducted in real-time between an originating user of the originating device and the target user of the target device (See col. 6, lines 63-67)

c. As per claim 3, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the step of determining includes the step of detecting whether an instant messaging application of the target device is active (See col. 7, lines 8-20).

d. As per claim 4, Manabe et al in view of Whitten, II teaches the claimed invention as

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described above. Furthermore, Manabe et al teaches configuring the canned reply by the target device before the step of receiving the communication message from the originating device (See col. 7, lines 43-45).

e. As per claim 11, Manabe et al teaches a data network system for responding to a communication message, the data network system comprising: a messaging server for communicating with a plurality of client devices, the messaging server being effective to route the communication message from an originating device to the target device (See col. 6, lines 23-26 and figure 1); to send the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 3, lines 45-60). However, Manabe et al fails to teach to receive a communication message directed to a target device from an originating device, retrieve a plurality of classes and a plurality of canned replies associated with the target device, identify an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating device.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203. Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators



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as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

f. As per claims 6 and 16, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the originating device exist (See col. 7, lines 1-7).

g. As per claims 8 and 18, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the target device exist (See col. 9, lines 55-64).

h. As per claim 12, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the messaging proxy is

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incorporated within the messaging server (See col. 4, lines 24-29).

i. As per claim 13, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the target device includes an instant messaging application that is active (See col. 7, lines 25-40).

9. Claims 5, 7, 9, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of Whitten, II as applied to claim 1 and 11 above, and further in view of U.S. Patent No. 6,430, 604 to Ogle et al.

a. As per claims 5 and 15, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device.

Ogle et al teaches a technique for enabling messaging systems to use alternative message delivery mechanism. Furthermore, Ogle et al teaches wherein if the test has a negative result then the message can not be sent (See col. 11, lines 4-14).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in order to enable

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messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

b. As per claims 7 and 17, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices.

Ogle et al teaches the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices (See col. 8, lines 30-55).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

c. As per claims 9 and 19, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of

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routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area.

Ogle et al teaches the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area (See col. 3, lines 36-49).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area as taught by Ogle in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

10. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Paten U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993564 to Whitten, II as applied to claim 1 and 11 above, and further in view U.S. Patent 6,301603 To Aravamudan et al.

a. As per claims 10 and 20, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the

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step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication.

Aravamudan et al teaches an assignable associate priorities for user-definable instant messaging buddy groups. Furthermore, Aravamudan et al teaches the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication (See col. 7, lines 20-65).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication as taught by Aravamudan et al in the claimed invention of Manabe et al in view of Whitten, II in order to provide features and capabilities associated with existing and emerging Instant messaging services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action (See col. 2, lines 25-30).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993,564 to Whitten, II as

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applied to claim 1 and 11 above, and further in view of U.S. Patent Application No 2004/0048615 to Kato et al

a. As per claim 14, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device.

Kato et al teaches a mobile packet communication system. Furthermore, Kato et al teaches a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device (See page 5, paragraph [0095]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device as taught by Kato et al in the claimed invention of Manabe et al in view Whitten, II in order to store for each mobile terminal address the current location of the corresponding mobile terminal 9See page 5, paragraph [0095]).

### *Conclusion*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878.

The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER